

Application No.: 09/682,076

REMARKS

Applicants wish to thank the Examiner for the telephonic interview conducted on 3/3/2005, where agreement was not reached with respect to patentable claims over the prior art of record. The interview was conducted via telephone and attended by Examiner Patrick L. Edwards, and Applicants' representative William R. McCarthy III. The subject matter of the interview included discussion of the claimed limitation of a user selection of one or more grid-aligning parameters where the grid-aligning parameters include an estimation of probe feature size. In the discussion Applicants respectfully disagreed with the Examiners assertion that such a limitation is taught by Shams (USPN 6,349,144) that is the basis of the rejection asserted under 35 U.S.C. §102(e). In particular, the Examiner maintains that given the broadest reasonable interpretation of the term "estimated" that the description in Shams of a user selection of a region in an image; and a user selection of a number of rows and a number of columns that correlates to a number of spots within the region, where the rows and columns are equally spaced within the selected region, implicitly anticipates the claimed limitation of a user selection of a grid aligning parameter that includes an estimation of probe feature size. Mr. McCarthy respectfully disagreed with such an interpretation maintaining that there is no description in Shams of any selection of probe feature size and in particular there is no described correlation of a probe feature size with the selection of an area that bounds a number of probe features or by a selection of a number of rows and columns with equal spacing within the selected area. Without saying that the claims would be allowable, the Examiner

Application No.: 09/682,076

did indicate that if the term "estimated" were removed the claims would avoid the Shams reference.

Examiner Edwards and Mr. McCarthy also discussed the rejections of claims 9 and 26 made under 35 U.S.C. §112 and were able to agree that a user selection of a dimension of a depositing element and its relationship to probe feature size is illustrated as element 920 of Figure 9 and described on page 32, line 16 *et seq.* of the specification, thus the limitations of each of claims 9 and 26 are definite and described and that the rejections should be withdrawn.

Mr. McCarthy also followed up with a call to Examiner Edwards on 3/9/2005 for clarification on the Examiner's point of view with respect to the user selection of a dimension of a deposit pin as a measure of probe feature size and its relationship to the prior art. Examiner Edwards did not have the application file to refer to during the call but did not believe that the discussed limitations were described in the prior art references of record.

Applicants would like to reiterate that both the interview and follow up call were found to be very helpful in advancing the prosecution of the present application.

Applicants appreciate the withdrawal of the previous objections to the specification and the rejections to claims 18-25 under 35 U.S.C. §101.

Upon entry of this response, claims 1-6, 8-23, 25-33 are pending, and of these, claims 1, 18, 27, 32, and 33 are independent.

Application No.: 09/682,076

In the interest of advancing prosecution of the present application, Applicants have amended claims 1, 18, 27, 32, and 33 to incorporate the limitation of the one or more grid aligning parameters that include a measure of probe feature size. Similarly, claims 9 and 26 have been amended to incorporate the limitation of the measure of probe feature size that includes a dimension of a depositing element. The support for the amendments may be found in Figure 9 and on page 32, line 16 *et seq.* as described in greater detail below with respect to the rejection under 35 U.S.C. §112.

Applicants respectfully assert that no new matter is presented by these amendments and further assert that the amendments place the application in condition for allowance. Therefore, Applicants respectfully request entry of the same.

Reply to Claim Rejections – 35 U.S.C. §112

Claims 9 and 26 are newly rejected under 35 U.S.C. §112 as failing to comply with the written description requirement and as being indefinite.

As discussed in the telephonic interview, the Examiner and Applicants reached agreement that a user selection of a grid aligning parameter comprising a measure of a probe feature size that includes a dimension of a deposit element is illustrated as element 920 of Figure 9 and described on page 32, line 16 *et seq.* that states:

“As indicated by graphical element 920, user 701 may also select an estimated feature size. For instance, if the probe features are

Application No.: 09/682,076

deposited using a pin, such as ones employed using the Pin-and-Ring™ technology of the Affymetrix® 417™ or 427™ Arrayers, then user 701 may select a pin size, e.g., 125 microns as shown in element 920.”

Therefore, Applicants respectfully request that the rejections of each of claims 9 and 26 under 35 U.S.C. §112 be withdrawn.

Reply to Claim Rejections – 35 U.S.C. §102(e)

The Examiner has maintained the rejection of claims 1-6, 8-9, 13-23, 25-28, and 30-33 under 35 U.S.C. §102(e) as being anticipated by Shams (USPN 6,349,144).

Applicants have amended each of independent claims 1, 18, 27, 32, and 33 to incorporate the limitation of the one or more grid aligning parameters that include a measure of probe feature size. As discussed with Examiner Edwards, Applicants assert that Shams does not teach the limitation of receiving a user selection of one or more grid aligning parameters that include a measure of probe feature size.

Therefore, Applicants respectfully assert that each of claims 1, 18, 27, 32, and 33 are patentable and respectfully request that the rejections be withdrawn. Also, claims 2-6, 8-9, 13-17, 19-23, 25-26, 28, and 30-31 each depend from one of claims 1, 18, 27, 32, or 33 in their chain of dependency and are thus each patentable for the same reasons.

Application No.: 09/682,076

Reply to Claim Rejections – 35 U.S.C. §103(a)

The Examiner has maintained the rejection of claims 10-12 and 29 under 35 U.S.C. §103(a) as being unpatentable over Shams as applied to claims 1, and 27, in view of Ramm et al. (USPN 6,345,115).

Applicants respectfully assert that independent claims 1 and 27 as amended are not anticipated by Shams for the reasons described above, and are therefore patentable. Therefore, the Applicants assert that claims 10-12 and 29 are not obvious under 35 U.S.C. §103(a), and the rejection should be withdrawn.

Application No.: 09/682,076


CONCLUSION

For these reasons, Applicants believe all pending claims are now in condition for allowance. If the Examiner has any questions pertaining to this application or feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at (781) 280-1522.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account 01-0431.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

By 

William R. McCarthy III Reg. No.: 55,788

Customer No.: 22886
Legal Department
Affymetrix, Inc.
3380 Central Expressway
Santa Clara, CA 95051
Tel: 781/280-1522
Fax: 781/687-9090